

REMARKS

Applicants acknowledge receipt of an Office Action dated April 18, 2008. In this response, Applicants have cancelled claim 7 without prejudice or disclaimer. In addition, Applicants have amended claims 1-5 and 49 and have added claims 50-58. Following entry of these amendments, claims 1-6, 8-12, and 14-58 are pending in the application. Claims 14-48 have been withdrawn from consideration and Applicants have reserved the right to request rejoinder of these claims under the provisions of MPEP §821.04. Thus, claims 1-6, 8-12, and 49-58 are currently pending and under consideration.

Although this reply to the outstanding Final Office Action includes amendments to the claims and presents new claims for consideration, Applicants submit that entry of the amendments is proper since Applicants are submitting this reply together with a Request for Continued Examination (RCE).

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Express Request for Interview

Applicants expressly request a personal interview and request that the Examiner contact the undersigned at the telephone number listed below in order to schedule a day and time for the interview.

Rejection Under 35 U.S.C. § 102

On page 2 of the Office Action, the PTO has rejected claims 1-3, 5 and 7-11 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.K Patent Birchall *et al.* to 2010287 (hereafter "Birchall"). Applicants traverse this rejection for the reasons set forth in their previously filed responses and for the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Here, Birchall fails to disclose “an oxidized compound having hydrophobic groups and first polar groups which are directly bonded to a surface thereof” as recited in independent claim 1. Applicants incorporate by reference here the arguments set forth in their previously filed response. Applicants acknowledge the PTO’s remarks at the bottom of page 2 of the Office Action and at the top of page 3 but wish to point out that mere possibilities are insufficient to establish anticipation. Taking the position that a document is not limited to an example, even assuming *arguendo* that the position is correct, does not resolve the deficiencies in Birchall.

Furthermore, in this response, Applicants have amended independent claim 1 to recite that “each of the hydrophobic groups is a group –OR₁, in which R₁ represents a non-polarized group and is a first organosilicon compound containing an alkyl group, allyl group, or aryl group.” Applicants respectfully request reconsideration of the outstanding rejection of claim 1 in view of this amendment.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 102.

Rejection Under 35 U.S.C. § 103

On page 2 of the Office Action, the PTO has rejected claims 4, 6 and 49 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.K. Patent Birchall et al. to 2010287 (hereafter “Birchall”).

Also on page 2 of the Office Action, the PTO has rejected claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.K. Patent Birchall et al. to 2010287 (hereafter “Birchall”) in view of European Patent Zaima et al. to 0885937 (hereafter “Zaima”).

Applicants traverse these rejections for the reasons set forth in their previously filed responses and for the reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Birchall and Zaima, whether taken individually or in combination, fail to teach or suggest "an oxidized compound having hydrophobic groups and first polar groups which are directly bonded to a surface thereof" as recited in independent claim 1. Zaima fails to resolve the deficiencies in Birchall referenced above. For at least this reason, Applicants submit that the outstanding rejection based upon Birchall and the combination of Birchall and Zaima is improper and ought to be withdrawn.

In this response, Applicants have amended independent claim 1 to recite that "each of the hydrophobic groups is a group $-OR_1$, in which R_1 represents a non-polarized group and is a first organosilicon compound containing an alkyl group, allyl group, or aryl group." Applicants respectfully request reconsideration of the outstanding rejection of claims 4, 6, and 49 in view of this amendment to independent claim 1.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 4, 6, 12, and 49, each of which ultimately depends from independent claim 1, are also non-obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

Newly Added Claims 50-58

In this response, Applicants have added claims 50-58. None of the references relied upon in the outstanding rejections, taken either individually or in combination, disclose, teach, or suggest the combination of features set forth in independent claim 50. Applicants note that claims 51-58 each depend from claim 50 and each recite additional features which, when considered in combination with the features recited in claim 50 are not disclosed, taught, or suggested by the references relied upon by the PTO in the outstanding rejections.

CONCLUSION

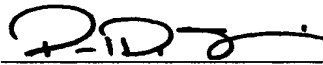
Applicants believe that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 10/17/08
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Paul D. Strain
Registration No. 47,369
Attorney for Applicant